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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,569	02/01/2002	Gordon Ko	5981	2762

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EXAMINER

ENGLE, PATRICIA LYNN

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,569

Applicant(s)

KO, GORDON

Examiner

Patricia L Engle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

DETAILED ACTION

Specification

1. The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The Examiner recommends that the term "hook and loop fastener" be substituted for "Velcro fastener". If the Applicant does not wish to remove the reference to "Velcro" the generic term of hook and loop fastener must be included in the specification to define "VELCRO" and the word must be in all capital letters.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "relatively easy" in claims 1, 11 and 19 is a relative term which renders the claim indefinite. The term "relatively easy" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the

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invention. How is relatively easy defined? What makes the shields relatively easy to handle roll and store?

5. Regarding claims 9, 17, 21 and 24, the phrase "preferred" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

6. Claims 7, 15, 19, and 22 contains the trademark/trade name VELCRO. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a hook and loop fastener and, accordingly, the identification/description is indefinite.

7. Regarding claim 22, the limitations in claim 22 are recited in the independent claim 19, lines 10-13. It is unclear how claim 22 further limits claim 19.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-9, 11-17, 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spears (US Patent 4,810,013) in view of McNeil (US Patent 4,810,015) and Huard (US Patent 4,974,892).

Spears discloses a removably attachable shielding to protect vehicle side surfaces and doors to prevent dents and scratches imposed by doors of adjacent vehicles, said shielding comprising: two shield pads (11a,11b) of impact absorbing material, at least one strap (19,21,23) secured to a lateral edge portion (43) of each of said shield pads (11a,11b) to connect them together, an elastic strap (27) having an end thereof secured to an edge portion (45) of a first one (11a) of the shield pads, and fastener means (57) for detachably securing a second end portion (25) of the elastic strap (27) to a second one of the shield pads. Regarding claim 2, Spears discloses that the shield pads (11a,11b) are sized and configured to cover a principal area of a vehicle's side surfaces and doors (29). Regarding claims 3 and 11, Spears discloses that the two spaced apart straps extend between and are secured to lateral edge portions (43) of the two shield pads (11a,11b).

Spears does not disclose the suction cups are used to attach the pads to the vehicle or that the pads are rolled up together.

Huard discloses a shield pad for a vehicle which is attached to the vehicle by a suction cup. Regarding claims 4 and 12, Huard discloses two spaced apart suction cups to attach the shield to the door in Figure 3.

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Huard and Spears are analogous art because they are from the same field of endeavor, i.e., protective pads for vehicle sides and vehicle doors.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to mount the shield pads with suction cups.

The motivation would have been to prevent the shield pads from moving around on the vehicle side when installed.

McNeil discloses a shield pad for a vehicle side door which is made of a material which can be rolled.

McNeil and Spears are analogous art because they are from the same field of endeavor, i.e., protective pads for vehicle sides and vehicle doors.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to make the pad of a material which is capable of being rolled as it would merely involve the alternate utilization of an equivalent material to achieve the same exact function of protecting the vehicle.

Therefore, it would have been obvious to combine McNeil and Huard with Spears to obtain the invention as specified in claim 1, 2, 3, 4, 11, 12.

Regarding claims 5, 7, 13, 15 and 19, Spears as modified does not disclose that the elastic strap is connected to an edge portion of one of the shield pads. However, it would have been obvious to one of ordinary skill in the art to allow the elastic strap to be joined to one of the shield pads to hold the shield pads in the compact position, as taught by an umbrella.

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Regarding claims 6 and 14, Spears does not disclose that the two spaced apart straps are secured to an edge portion of the shield by riveting. McNeil discloses that it is known to attach straps to edge portions of shields by riveting (column 2, lines 65-66). It would have been obvious to one of ordinary skill in the art at the time of the invention to connect the straps to the shield pads by rivets as taught by McNeil. The motivation would have been to simplify the connection of the straps and the shields.

Regarding claims 8, 9, 16, 17, 20, 21, 23 and 24, Spears does not disclose that the shield pads are made from a blend of neoprene rubber, ethylene propylene, styrene butadiene rubber or ethylene vinyl acetate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use these materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of mechanical expedient.

10. Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spears as modified as applied to claims 1-9, and 11-17 above, and further in view of Hwang et al. (US Patent 6,155,329).

Spears as modified discloses the shield pad as claimed in claims 1-9 and 11-17.

Spears as modified does not disclose that the shield can be used as a sun shade.

Hwang et al. disclose a sun shade made with two shield pads.

Spears as modified and Hwang et al. are analogous art because they are from a similar problem solving area, i.e., protecting a vehicle with two shield pads.

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At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the shield pad of Spears as modified as a sun shield.

The motivation would have been to increase the market sales of the shield by demonstrating its dual capabilities.

Therefore, it would have been obvious to combine Hwang et al. with Spears to obtain the invention as specified in claims 10 and 17 .

Double Patenting

11. Claims 19, 23 and 24 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 7, 20 and 21. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gomez et al., Henderson et al., Cruz, Brown and Swinton disclose shields for vehicle doors and sides. Shink and Berty disclose sun shades.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L Engle whose telephone number is (703) 306-5777. The examiner can normally be reached on Monday - Friday from 8:00 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (703) 308-3102. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Patricia L Engle
Examiner
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July 15, 2002

A handwritten signature in black ink, appearing to be 'D. Glenn Dayoan', followed by the date '7/15/02'.

D. GLENN DAYOAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600